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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,483	05/01/2001	Laurent Chambard	2000M005	7731

7590 07/26/2002  
Infineum USA L.P.  
Law Department  
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Linden, NJ 07036-0710

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 07/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/846,483

Applicant(s)

CHAMBARD ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (4,283,294) and Fujitsu et al (6,114,288), considered separately.

Applicants' arguments filed 7 May 2002 have been fully considered but they are not persuasive. As set forth in the previous office action, Clarke discloses lubricating oil compositions suitable for use in low speed crosshead diesel engines which are normally used for marine propulsion comprising 60 to 85 parts by weight of lubricating oil, 15 to 30 parts by weight of a mixture of more than 50 weight % of a Group IIa metal overbased detergent and up to 50 weight % of a Group Ia metal overbased detergent and 0.2 to 5 parts by weight of an antioxidant, provided the molecular weight ratio of the overbased detergent mixture to antioxidant lies between 7.5:1 and 50:1. The lubricating oil may be an animal, vegetable, mineral oil or synthetic oil and is preferably a hydrocarbon oil such as mineral oil. See column 1, lines 17-44. Suitable overbased detergent additives include alkali metal or alkaline earth metal phenates, sulphonates, and salicylates. See column 1, line 67 to column 2. See especially lines 43-55 of column 2, where overbased calcium salicylate is taught. Applicants argue that one of ordinary skill in the art would not be led by the disclosure of Clarke to expect that any improved performance would result from the use of a salicylate as the sole overbased detergent.

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Although Clarke does not prefer the salicylate metal salts over the phenate and sulphonate metal salts, Clarke still teaches salicylate metal salts as suitable detergents for the marine engine lubricant composition. The examiner maintains the position that the overbased detergent additives of Clarke clearly meet the limitation of claimed component (B) which is broadly drawn to "an oil-soluble overbased metal detergent additive, as the sole overbased metal detergent, consisting of one or more aromatic carboxylates". Applicants argue that there is nothing in Clarke that would lead one to exclude a dispersant and expect engine cleanliness and dispersing properties could be maintained. This is not deemed to be persuasive because Clarke does not require the addition of a dispersant; Clarke merely teaches that "if desired, a small amount... of a dispersant" may be added to the composition. As previously set forth, antioxidants such as zinc dialkyldithiophosphate may be added to the composition. Thus, the examiner maintains of the position that the oil compositions of Clarke meet the limitations of the claims when the detergent component is an overbased salicylate.

Fujitsu et al ["Fujitsu"] disclose lubricating oil compositions for internal combustion engines comprising a base lubricating oil, (1) a zinc dithiophosphate and (2) a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate and, optionally, (3) a friction modifier. The examples set forth in Table 2 comprise compositions with metallic detergent A, a calcium salicylate having a TBN of 150 mg KOH/g; metallic detergent B, a calcium salicylate having a TBN of 80 mg KOH/g; and metallic detergent C, a magnesium salicylate having a TBN of 340 KOH/g. See examples 1 and 2 which also comprise wear resistance agent A which is a secondary zinc dithiophosphate. The examiner

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maintains the position that these examples meet the limitations of the claimed compositions. Applicants argue that such compositions should be assumed to contain dispersants which differs from the instant invention. This is not deemed to be persuasive because dispersants are not required to be present in the composition; Fujitsu teaches in column 4, lines 50 et seq. that the compositions *may* additionally contain an ash-free dispersant, an antioxidant, and other conventional additives.

The rejection under 35 USC 103(a) as being unpatentable over Brook et al (3,625,893) is withdrawn in view of applicants' arguments; specifically that the oil compositions have a TBN of 5-12 which differs from the TBN of at least 25 of the claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
July 24, 2002